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EXAMINER
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MISIASZEK, MICHAEL

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3625

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/821,275  
Filing Date: April 09, 2004  
Appellant(s): TAN ET AL.

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Anthony C. Murabito  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11/9/2009 appealing from the Office action mailed 10/15/2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

2002/0010661	Waddington et al.	01-2002
2003/0149662	Shore	08-2003

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-15, 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Waddington et al.

#### Regarding Claims 1-4

Waddington discloses a method of creating invoices for goods or services supplied to a buyer from a supplier, comprising:

- receiving the goods or services at the buyer, the receipt of the goods or services evidenced by a receipt document (at least paragraph [0011]: item delivery and receipt record)
- the buyer generating invoices based on the receipt document and providing the generated invoices to the supplier (at least paragraph [0011]: buyer verifies contents using shipping record and item lists)

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- wherein the receipt document reflects actual goods or services received by the buyer (at least paragraph [0011]: receipt record includes shipping unit and discrepancies)
- wherein the buyer pulls the goods or services from the supplier (at least paragraph [0010]: customer obtains items from retail store through distribution center)
- wherein a third party logistics warehouse system is interposed between the supplier and the buyer, such that the third party logistics warehouse system receives the goods or services from the supplier and makes the goods or services available to the buyer (at least paragraph [0010]: distribution center)

Regarding Claims 5-9

Waddington further discloses:

- wherein the buyer pulls the goods or services from the third party logistics warehouse system (at least paragraph [0010]: customer obtains items from retail store through distribution center)
- checking the generated invoices and determining whether the generated invoices are approved prior to providing the generated invoices to the supplier (at least paragraph [0011]: obtaining customer signature)
- the buyer generating reports based on the generated invoices, the reports containing logistical data (at least paragraph [0011]: creating list of discrepancies)

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- a plurality of suppliers that supply the goods or services to the buyer, the plurality of suppliers being identifiable by the buyer such that a particular supplier supplying particular goods or services is identified by the buyer upon receipt of the goods or services (at least figures 1 and 3: plurality of retail stores and retail store identifier on shipping label)
- determining whether goods are returned to the supplier, and generating a debit memo if goods have been returned to the supplier (at least paragraph [0010]: returns record)

#### Regarding Claims 10-15

Waddington discloses a computer readable media bearing instructions that cause a computer at a buyer to:

- determine at the buyer that goods have actually been received at the buyer (at least paragraph [0011]: electronically verifying delivery contents)
- create an invoice at the buyer based on the determination that goods have actually been received at the buyer (at least paragraph [0011]: electronically creating receipt and shipping records)
- wherein the instructions further cause the computer to generate an invoice report and forward the invoice report to a vendor (at least paragraph [0123]: records sent to retailer)
- wherein the determination at the buyer that goods have actually been received includes inputting a receipt traveler upon verification of goods received at the

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buyer (at least paragraph [0011]: receipt record and signature confirmation from buyer)

- wherein the instructions further cause the computer to create a purchase order for goods (at least paragraph [0077]: order for items generated)
- wherein the instructions further cause the computer to forward the invoice to an invoice approval process prior to generating an invoice report (at least paragraph [0011]: customer signature)
- wherein the instructions further cause the computer to generate a debit memo when goods are returned to a vendor (at least paragraph [0010]: return records created)

#### Regarding Claims 17-20

Waddington discloses an invoicing system for goods and services, comprising:

- a computer system (at least figure 4)
- means for creating invoices from the computer system at a buyer based on goods or services actually received at the buyer (at least paragraph [0011]: electronically creating receipt and shipping records)
- wherein the means for creating invoices includes means for creating the invoices based on receipt documents that document the actual receipt of the goods or services at the buyer (at least paragraph [0011]: electronically creating receipt and shipping records)
- means for providing an invoice report to a vendor based on the invoices created at the buyer (at least paragraph [0123]: delivery reports sent to retailer)

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- means for generating a debit memo to the vendor when goods are returned to the vendor (at least paragraph [0010]: receipt reports generated)

2. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waddington et al. in view of Shore.

Waddington discloses the claimed invention except for:

- the instructions further cause the computer to forward the invoice report to the vendor by electronic mail.

Shore teaches that it is known to include forwarding an invoice by electronic mail (at least paragraph [0199]) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invoicing method and system, as taught by Waddington, with the invoice forwarding by electronic mail, as taught by Shore, since such a modification would have provided a mobile, user-friendly purchasing means for electronic transactions (at least paragraph [0004] of Shore).



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3. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waddington.

Waddington substantially discloses the claimed invention, as detailed with claims 1 and 17 above. Waddington does not explicitly disclose that the invoices created by the buyer include both quantity and prices of supplied goods or services. However, applicant's own specification (see paragraph [04]) acknowledges that an invoice including both quantities and prices of goods or services is common practice. Such disclosure is considered by the Examiner to be an admission of prior art. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the system and method, as taught by Waddington, to have included both quantity and price on a buyer created invoice.

**(10) Response to Argument**

On page 13 of the brief, with regard to claims 1-9, appellant asserts that Waddington does not disclose the limitations: "receiving the goods or services at the buyer, the receipt of the goods or services evidenced by a receipt document; And the buyer generating invoices based on the receipt document and providing the generated invoices to the supplier". Appellant argues that Waddington's disclosure is the opposite of claim 1. The Examiner respectfully disagrees. In the cited portions of Waddington, a buyer receives goods from a supplier, where the receipt of the goods is evidenced by a shipping record, and a listing of items within the shipped container. The customer then verifies the shipment to the supplier by identifying the discrepancies between the shipping record/list of items and what is actually within the container and subsequently confirming the discrepancies via a signature. The identification of discrepancies and signature confirmation is the process with which the buyer generates an invoice, and provides the invoice to the supplier as claimed.

While appellant argues, on pages 13-14 of the brief, that the Examiner's arguments concerning the definition of the word "invoice" are a distraction, the Examiner asserts that such arguments are at the heart of the issue of the disclosure of Waddington. Previously in prosecution, appellant provided a definition of the word "invoice" that is consistent with the present specification. The provided definition was "an itemized list of goods shipped usually specifying the price and the terms of sale". In Waddington, a list of items that are supposed to be in a container shipped to the buyer

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is provided to the buyer. By identifying the discrepancies between this list and the actual contents of the container, and subsequently confirming with a signature, the customer creates a list of goods that were actually shipped, which is relayed to the deliverer/supplier. Thus, the buyer in Waddington creates an invoice (a list of goods that **were** shipped), and provides the invoice to the supplier.

Further on page 14 of the brief, appellant argues that the “Applicants’ definition in the specification controls the meanings of the terms appearing in the Claims.” However, there is no explicit definition of the term “invoice” in the specification. Thus, it is acceptable for the Examiner to apply the customary definition to the term. The definition provided previously by the applicant, as noted above, falls under the umbrella of a customary definition. Accordingly, appellant’s arguments with regard to claims 1-9 are not persuasive.

On pages 14-18 of the brief, appellant presents arguments with regard to claims 10-15 and 17-20 that parallel to those presented with regard to claims 1-9, as addressed above. Accordingly, appellant’s arguments with regard to claims 10-15 and 17-20 are not persuasive for the same reasons arguments with regard to claims 1-9 are not persuasive.

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On page 19 of the brief, appellant argues that claim 16 is not properly rejected, as it does not remedy the asserted deficiencies of Waddington. Accordingly, appellant's arguments with regard to claim 16 are not persuasive for the same reasons arguments with regard to claims 1-9 are not persuasive.

On pages 21-23 of the brief, appellant presents arguments with regard to claims 21-23 that parallel to those presented with regard to claims 1-9, as addressed above. Accordingly, appellant's arguments with regard to claims 21-23 are not persuasive for the same reasons arguments with regard to claims 1-9 are not persuasive.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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